

REMARKS

Summary of the Claims

With the present Office Action, claims 1-24 were pending in the application and were rejected. No claim amendments have been made.

Rejections under 35 U.S.C. § 102

Claims 1, 2, 7, 8, 13, 14, 19, and 20 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Pat. App. Pub. No. 2002/0198629 to *Ellis*. We traverse this rejection

Legal Standard

As is known, the burden is on the Office to establish a prima facie case of anticipation.¹ The legal standard of anticipation has been settled by a large body of common law over the last century. A prima facie case of "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration."² It is not enough for each word or element to appear in a single prior art reference, rather, "[a]nticipation requires...[that the single prior art reference disclose]...each and every element of the claimed invention, *arranged as in the claim [at issue]*."³

Aside from the single prior art reference disclosing each and every element, arranged as in the claims at issue, courts also have noted that "there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in [the art]."⁴ Even principles upon which the claimed invention operates must be consistent, since "[a] device [that] does not operate on the same principle [as the claimed device] cannot be an anticipation."⁵

¹ *In re Skinner*, 2 U.S.P.Q.2d 1788, 1788-89 (B.P.A.I. 1986).

² *W. L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983).

³ *Id.* 220 U.S.P.Q. at 313 (*emphasis added*).

⁴ *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991).

⁵ *Los Alamitos Sugar Co. v. Carroll*, 173 F. 280, 284 (9th Cir. 1909).

Furthermore, the law of anticipation does not allow speculation, substitution, and/or rework. For example, “[i]t is not sufficient to constitute anticipation that the devices relied upon *might*, by a process of modification, reorganization, or combination with each other, be made to accomplish the function performed by the [claimed] device.”⁶

If a reference does not explicitly set forth each and every element of the claim(s) at issue, inherency can be relied upon to demonstrate these elements. However, with respect to inherency, the CCPA has noted that “[i]nherency [is not] established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient[, rather, the element or function *must necessarily* result from the prior art reference.]”⁷

Finally, mere disclosure of the claimed features is not necessarily sufficient. Rather, the cited reference must also teach the claimed invention in an enabling manner.⁸ This requirement is consistent with the requirement that each and every element exist in the cited reference without making any modifications to the reference.

A prima facie case of anticipation, therefore, requires that 1) the Patent Office establish⁹ that 2) a single prior art reference¹⁰ 3) teaches in an enabling manner¹¹ 4) each of the claimed elements as arranged in the claims¹² 5) expressly or inherently¹³ 6) as interpreted by one of ordinary skill in the art.¹⁴

As will be explained below, the Office Action fails to establish a prima facie case of anticipation under 35 U.S.C. § 102 for any claim of the application. As such, all of the rejections under 35 U.S.C. § 102 must be withdrawn.

⁶ *Id.* at 285 (*emphasis added*).

⁷ *In re Oelrich*, 666 F.2d 578, 581 (C.C.P.A. 1981)(quoting *Hansgird v. Kemmer*, 102 F.2d 212, 214 (C.C.P.A. 1939)(*emphasis added*).

⁸ *Akzo N.V. v. U.S. Int’l Trade Comm’n*, 808 F.2d 1471, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986).

⁹ FN 7, *supra*.

¹⁰ FN 3, *supra*.

¹¹ FN 8, *supra*.

¹² FN 3, *supra*.

¹³ *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

¹⁴ FN 4, *supra*.

The Rejections Fail to Satisfy the Legal Standard

Claim 1 is directed to a method for automated tracking of events associated with a billing cycle for use in connection with a computerized billing system. The method includes, *inter alia*, "retrieving a billing schedule specifying a plurality of billing cycle events for the billing cycle." While *Ellis* is described in the Office Action as teaching this explicit claim feature, no such teaching exists in *Ellis*. Paragraph 0078 of *Ellis*, cited in the Office Action as teaching this feature, merely discusses a user interface feature for selecting alternate billing cycles or specific dates for a billing cycle. As opposed to teaching, as claimed, "a billing schedule...[that specifies]...a plurality of billing cycle events for the billing cycle," *Ellis* only discusses alternate billing cycles being offered to a customer for selection via a user interface. A billing schedule that specifies a plurality of billing cycle events for a billing cycle cannot be properly construed as equivalent to an alternate billing cycle.

The method further includes, *inter alia*, "identifying a first billing cycle event from the plurality of billing cycle events." While *Ellis* is described in the Office Action as teaching this explicit claim feature, no such teaching exists in *Ellis*. Paragraph 0083 of *Ellis*, cited in the Office Action as teaching this feature, merely discusses a user specifying a billing cycle that is non-standard. As opposed to teaching, as claimed, "identifying a first billing cycle event from the plurality of billing cycle events," *Ellis* only discusses a user specifying a non-standard billing cycle. A billing schedule that specifies a plurality of billing cycle events for a billing cycle cannot be properly construed as equivalent to a non-standard billing cycle. Further, identifying a first billing cycle event of a billing cycle cannot be properly construed as equivalent to specifying a non-standard billing cycle.

Since *Ellis* is completely silent on the aforementioned and explicitly claimed features, *Ellis* does not, and cannot, anticipate at least independent claim 1 of the application. Claims 7, 13, and 19 also recite, *inter alia*, the features of claim 1 discussed above, and, accordingly, are patentable over *Ellis*

for at least the same reasons cited above with respect to claim 1. Since claims 1, 7, 13, and 19 are not anticipated by *Ellis*, each claim depending from claims 1, 7, 13, and 19 including claims 2-6, 8-12, 14-18, and 20-24, respectively, is patentable over *Ellis* for at least the reasons cited with respect to claim 1 and on their own merit.

In summary, *Ellis* is not directed to the subject matter of the claims of this application, and does not teach the features of the claims. Since each of the independent claims of the application is patentable over *Ellis*, all of the claims of this application are patentable over *Ellis* for at least the reasons described immediately above.

The Applicant respectfully submits that the Office fails to establish proper rejections of any of the claims under 35 U.S.C. § 102.

Rejections Under 35 U.S.C. § 103

Claims 3-6, 9-12, 15-18, and 21-24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ellis* in view of U.S. Pat. No. 5,517,555 to *Amadon et al.* We traverse this rejection.

According to existing case law regarding rejections under 103, it is noted that each and every element of the claims must be taught or suggested by the applied references, individually, or in combination, without the benefit of impermissible hindsight.¹⁵ Furthermore, each and every word of the claims at issue must be considered when judging the patentability of the claim at issue against the prior art.¹⁶

None of the applied references, either individually, or in any hypothetical combination with one another, teaches each feature of the claims, as will be explained in more detail below.

¹⁵ *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

¹⁶ *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *M.P.E.P.* § 2143.03.

It is first noted that nothing in *Amadon et al.* cures the deficiencies of *Ellis* discussed above. For at least these reasons, all of the claims of this application are patentable over *Ellis* and *Amadon et al.* alone, or in any proposed combination. It is additionally noted that claims 2-6, 9-12, 15-18, and 21-24 are patentable over the cited art at least because these claims depend from independent claims 1, 7, 13, and 19 that are patentable for at least the reasons described above.

With respect to claims 3, 5, 9, 11, 15, 17, 21, and 23 it is additionally noted that the Office Action attempts to justify the combination by claiming that it would have been obvious to a person of ordinary skill in the art to modify *Ellis* and include the steps of these claims in order to “exercise effective control over customer payments by sending timely notifications.” *Amadon et al.* discusses actions taken after a billing cycle has ended. The fact that each independent claim explicitly claims a first billing cycle event from the plurality of billing cycle events in the billing cycle precludes any billing cycle event occurring after a billing cycle has ended. Indeed, a billing cycle event within a billing cycle cannot occur after the billing cycle has expired.

As explained above, neither *Ellis* nor *Amadon et al.* teaches the features explicitly claimed by the Applicant in claims 3, 5, 9, 11, 15, 17, 21, and 23. As such, *Amadon et al.* cannot cure the deficiencies of *Ellis*.

With respect to claims 4, 6, 10, 12, 16, 18, 22, and 24, the Office Action asserts that “it is considered a design choice to create a web page indicating indicia representative of the first notification and a second notification” then offers a portion of *Amadon et al.* that cites no web page, but rather “terminals and printer[s] in the customer service center.” It is clear from the rejection that *Amadon et al.* does not discuss at least the explicitly claimed feature of a “web page” as acknowledged by the Office Action. The Applicant reminds the Office that each and every element of the claims must be taught or suggested by the

applied references, individually, or in combination, without the benefit of impermissible hindsight.¹⁷

Ellis and *Amadon et al.* do not teach all of the features of any of the claims, alone, or in any hypothetical combination. Therefore, the rejections under 35 U.S.C. § 103 must be withdrawn.

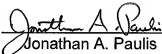
¹⁷ *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Conclusion

It is respectfully submitted that the present application is in condition for allowance and notice to that effect is hereby requested. Should any new concerns arise, Examiner Champagne is urged to please initiate a telephone interview with the undersigned representative to expedite prosecution of the present application.

No fee is believed due with the filing of this paper. The Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 50-3447.

Respectfully Submitted,
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